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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,804	07/02/2003	Edward B. Ferguson	1634.0080001/DKSC	9002
26111	7590	05/04/2004	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ESTREMSKY, GARY WAYNE	
			ART UNIT	PAPER NUMBER
			3676	

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/620,804

Applicant(s)

FERGUSON, EDWARD B.

Examiner

Gary W Estremsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/2/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Limitation of "said first magnet and said second magnet are of sufficient strength to,..." render the scope of the claims indefinite inasmuch as some range is required but it is not clear from the disclosure or claims what the extent of the range are whereby it is not reasonably possible for one of ordinary skill in the art to ascertain whether prior art fully teaches strength within claim scope without extensive testing. The limits of the range depend on unclaimed and forces of unknown magnitude related to slamming of a door.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Pat. No. 6,588,811 to Ferguson. Although the claims are not identical, the scope of the claims is not patentably distinct since when the claims are properly interpreted in light of the specification, the claims must be read on the same scope of invention.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 5-9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 3,790,197 to Parker.

Parker '197 teaches Applicant's claim limitations including : a "first magnet" - 15, "mounted on a door" - 11, a "second magnet" - 13, "mounted on a doorframe" - portion of 10 adjacent door, "switching means" - including 18, 22 where limitation of "switching means" has been disclosed in diverse embodiments including structural repositioning of permanent magnets by rotation of a knob or by disassembly and reassembly or by reversing poles of electromagnets. Consequently, the "switching means" limitation must also be interpreted broadly where the reference has disclosed position of magnets to

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reorient the poles for attraction/repulsion that being substantially the same as structure disclosed by Applicant. See MPEP 2181-2185.

As regards claims 6 and 7, the reference explicitly discloses magnetic attraction is intended to hold the door closed. It is the examiner's position that, in a repel situation, the magnet of the prior art applies a repulsion force that will inherently "diminish force" of a closing door where the limitation is broad since no particular range of diminishment of the slamming force is required. As a clarification, it should be noted that the limitation is properly interpreted as regards how it further defines structure of the claimed elements, and not as a method step in a *process of using*. See MPEP 2173.05(p), section II and MPEP 2114.

5. Claims 4-8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 3,647,165 to Whitla.

Whitla '165 teaches Applicant's claim limitations including : a "door" - 34, "at least partially formed from magnetic material" - 42 as shown in Fig 2 where (present disclosure and especially) the claim language is broad as regards providing any structural limitations for interpretation of 'formed from'. Whitla '165 also teaches : a "magnet" - 35, "mounted on a structure opposing the door" - 36, "configured to allow a user to selectively orient said magnet between a first position to repel the door and a second position to attract the door" - the magnet assembly has symmetrically arranged screw holes on opposite sides whereby it is inherently capable of being flipped over (with respect to the plane of the page and remounted in a position with opposite polarity

from that illustrated, not that such modification is suggested. That is to say, limitation of "configured to" is properly interpreted as functionally defining a capability within context of some intended use, but it does not define any particular structure that can be relied upon to patentably define from the well known structure of the prior art which is inherently capable of being mounted in two positions as described. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

As regards claim 5, the limitation of "switching means" has been disclosed in diverse embodiments including: structural repositioning of permanent magnets by rotation of a knob, or by disassembly and reassembly, or by reversing poles of electromagnets. Consequently, the "switching means" limitation corresponding with diverse disclosure is rightfully interpreted broadly where the reference has disclosed switching poles of an electromagnet that is substantially the same as structure disclosed by Applicant. See MPEP 2181-2185.

As regards claims 6 and 7, the reference explicitly discloses magnetic attraction is intended to hold the door closed. It is the examiner's position that, in a repel situation, the magnet of the prior art applies a repulsion force that will inherently "diminish force" of a closing door where the limitation is broad since no particular range

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of diminishment of the slamming force is required. As a clarification, it should be noted that the limitation is properly interpreted only as regards how it further defines structure of the claimed elements and not as a method step in a *process of using*. See MPEP 2173.05(p), section II and MPEP 2114.

### ***Claim Rejections - 35 USC § 103***

6. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 3,647,165 to Whitla.

Although Whitla '165 discloses the permanent magnet on the door and the electromagnet on the frame of the cabinet, it would have been obvious to one of ordinary skill in the art at the time of the invention, to reverse the structures as an engineering expedient or design choice in order to route the wiring to the door instead of the cabinet (should that be desired for aesthetic or marketing reasons) since such modification would not otherwise affect function of the device and since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. See MPEP 2144.04.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 2,584,480 to Manting.

U.S. Pat. No. 3,300,239 to Dinkin.

U.S. Pat. No. 3,596,958 to Bowerman.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary W Estremsky whose telephone number is 703 308-0494. The examiner can normally be reached on M-Thur 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703 306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary W Estremsky  
Examiner  
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